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In re Application of GARCIA COLLAZO et al :
U.S. Application No.: 10/593,928 :
PCT Application No.: PCT/EP2005/003033 : DECISION
Int. Filing Date: 22 March 2005 :
Priority Date Claimed: 22 March 2004 :
Attorney Docket No.: 102900-102 :
For: THYROID RECEPTOR AGONISTS :

This is in response to applicant's "Renewed Petition under 37 CFR 1.182" filed 28 February 2008.

BACKGROUND

On 22 March 2005, applicant filed international application PCT/EP2005/003033, which claimed priority of an earlier United Kingdom application filed 22 March 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 06 October 2005. The thirty-month period for paying the basic national fee in the United States expired on 22 September 2006.

On 21 September 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 18 May 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 01 June 2007, applicant filed an executed declaration.

On 27 August 2007, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that the declaration filed 01 June 2007 is improper.

On 18 October 2007, applicant filed a petition under 37 CFR 1.182.

On 19 December 2007, this Office mailed a decision dismissing the 18 October 2007 petition.

On 28 February 2008, applicant filed the present renewed petition under 37 CFR 1.182.

DISCUSSION

MPEP 1893.01(e), Correction of Inventorship, states in relevant part,

Where there has been no change of inventorship but the name of an inventor indicated in the international application during the international phase has changed such that the inventor's name is different from the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, for example, on account of marriage, then a petition under 37 CFR 1.182 will be required to accept the oath or declaration with the changed name. See MPEP § 605.04(c).

Pursuant to MPEP 605.04(c), a petition to change an inventor's name must include the appropriate petition fee and a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected or a copy of the court order. In the present case, the requisite petition fee has been provided. Furthermore, the petition contains the required statement from the inventor whose name has changed due to marriage. However, the inventor's new legal name "Anders Thomas Wilson Norin" as indicated in the statement does not match the name ("Thomas Anders Wilson Norin") listed in the executed declaration. Additionally, a review of the executed declaration reveals that the declaration is an improper composite document. More particularly, the declaration consists of one each of pages 1, 2, and 4 and three of page 3. It is not acceptable to combine pages from different copies of a declaration into a single document. Applicant must submit either: a single complete declaration which is presented to and executed by each of the inventors or (2) multiple complete declarations, wherein each of the inventors executes at least one of the multiple complete declarations.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.182 is GRANTED.

The application is being forwarded to the DO/EO/US for preparation and mailing of a Notification of Defective Response (Form PCT/DO/EO/916), which should indicate that applicant must submit a single complete declaration or multiple complete declarations as described above, wherein the legal name of the second inventor is properly indicated in the declaration(s).



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